IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. 09/544,507
Filing Date ..... Apr 06, 2000
Inventorship ..... Sierra et al.
Applicant..... Microsoft Corporation
Group Art Unit.....2174
Confirmation Number.....9078
Examiner ..... Nguyen, N.
Attorney's Docket No. MS1-486US
Title: Methods And Arrangements For Providing Non-Modal Reminder Information In A Graphical User Interface

REQUEST FOR RECONSIDERATION AS TO THE FINALITY OF THE OFFICE ACTION DATED OCTOBER 19, 2006

To: MS AF
Honorable Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

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This is in response to the Final Office Action mailed October 19, 2006, as a Reply to the Final Office Action is being filed concurrently it is believed no fee is due.

Reconsideration of the finality of the Office Action is respectfully requested.

REMARKS

Claims 1, 5, 9, 13, 17 and 21 are pending in the application.

Improper Final Rejection

By the Office's October 19, 2006 Action, the matter was placed under final rejection. Applicant disagrees. Specifically, the Office cited United States Patent Number 6,609,106 issued to Robertson, et al. (hereinafter, "Robertson"), in view of "well known art" (Instant Action, Page 4, first full paragraph) in its rejection of Claims 1, 5, 9, 13, 17 and 21 under 35 U.S.C. §103(a). This is to say the Office is utilizing the knowledge of one of ordinary skill in the art to fill-in the deficiencies in Robertson. The Office incorrectly recited that this basis, 35 U.S.C. §103(a) was the basis of the immediately preceding Action of May 3, 2006. *Instant Action*, Page 2, first full paragraph. This is incorrect. The Office Action of May 3, 2006 was based solely in 35 U.S.C. §102(e) over Robertson. Thus, the Immediate Action is the first citation of "well known art" and the Action failed to provide any basis as to why the new rejection was necessitated by the Applicant's amendment. As the Manual of Patent Examining Procedure notes:

> Under present practice, second or any subsequent actions on the merits shall be final, *except* where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). ...Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will *not be made final if it includes a rejection, on newly cited art*, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art. *M.P.E.P. §706.07(a) emphasis added.*

Therefore, Applicants believe that the finality of the pending rejections is improper as this is the first citation of "well known art." Moreover, Applicants believe that

the finality is improper because the Office utilized "well known art" to reject Claims 1, 5, 9, 13, 17 and 21, which was within the general search scope of the claims previously under consideration. In addition, if the finality of the pending Action were to be maintained, this would place an undue burden on Applicants' attempts to clarify issues for appeal. Removal of the finality of the pending action is respectfully requested.

CONCLUSIONS

In light of the forgoing, reconsideration of the finality of the Office Action is respectfully requested.

DATED: 12/19/6.

Respectfully submitted,

By _____

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